

REMARKS

Claim 17 has been canceled, and therefore claims 12 to 16 and 18 to 22 are now pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 12 and 21 were rejected under 35 U.S.C. § 112, first paragraph, as to enablement. Claims 13 to 20 and 22 were rejected as depending from either claim 12 or claim 21.

The enablement rejections are reversed. To make a § 112 rejection, the Office has the initial burden to establish a reasonable basis to question the enablement provided for the claim. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)) (discussed in MPEP § 2164.07 regarding the relationship of the enablement requirement to the utility requirement of 35 U.S.C. 101).

As further regards the enablement rejection under the first paragraph of 35 U.S.C. § 112, the following is respectfully submitted:

The standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (*See id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (*See* M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (*See id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (*See id.*).

It is believed that the present assertions of the Office Actions to date do not adequately address whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it does. In short, it is believed that to date the Office Actions’ arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claims. As explained, the Final Office Action did not address in any way (let alone refute) the explanation as to why the subject matter is enabled.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were

based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims.

In particular, the subjective assertions of the Office Action are simply not supported by any real "evidence or sound scientific reasoning" — which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection. No evidence has been offered by the Office and the only "reasoning" offered is that the Examiner believes that a person could not do so. The federal Circuit has made plain that this does not satisfy the evidentiary standard for establishing that a claim is not enabled based on the application.

In this regard, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (See id. at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Actions to date have not satisfied the foregoing for establishing that undue experimentation would be required since no evidence has been provided except for the wholly unsupported opinions of the Office as to the rejected claims.

Accordingly, withdrawal of the "enablement" rejections is respectfully requested.

Claims 12 to 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,335 ("Ide") in view of U.S. Patent No. 6,137,335 ("Khairallah").

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine

reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, the prior art must disclose or suggest each claim feature and it should also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). As explained herein, it is respectfully submitted that the cited references, whether considered alone or in combination, do not disclose or suggest all of the features of the claims.

Claims 13 and 16 have been rewritten to correct minor errors.

Although the rejections may not be agreed with, to simplify matters, claim 12 has been rewritten to incorporate the features of claim 17, which has been canceled without prejudice. Also, claim 18 has been rewritten to change its dependency from claim 17 to claim 12.

Claim 12, as presented, provides the feature in which a level of the first signal is reduced as a function of at least one of the second signal and a vehicle model. The Ide reference does not disclose or suggest at least this feature. Contrary to the assertion appearing on page 5, lines 3 to 5 of the Final Office Action, Figure 16 of Ide merely refers to an embodiment of a crash mode determining unit, including right and left acceleration sensors 240Re, 240Le and respective signal processing circuits 280R, 280L, central acceleration sensor 230, phase determining circuit 250, crash determining circuit 260 and determination output circuit 270. As part of the signal processing, the signals from the acceleration sensors are integrated and compared to threshold values for the ultimate purpose of determining if a driver airbag 220 needs to be activated, and if so, what level of inflation the airbag 220 must have. However, no level of a first signal is reduced as a function of a second signal or a vehicle model in calculating a trigger signal.

In addition, with respect to claim 18, which depends from claim 17 and whose additional features relate to the above-mentioned feature of claim 12, the Final Office Action implies, on page 5, lines 6 to 8, that Figure 15A of Ide shows the features of claim 18, that only level peaks of a first signal are reduced as a function of a second signal, or a level of a first signal is reduced by a predefined value as a function of a level of a second signal. However, as is apparent from column 11, lines 10 to 16 of Ide, Figure 15A merely indicates that right and left acceleration sensors 140R and 140L turn on and generate high-level acceleration signals when their measured accelerations exceed a threshold value TH. The Ide reference contains absolutely no discussion of reducing level peaks of a first signal as a function of a second signal or reducing the level of a first signal by a predefined value as a function of a level of the second signal.

Furthermore, the Khairallah reference refers to a vehicle occupant protection system 10 including X, Y and Z-direction accelerometers 56, 58, 60, a controller 38 and front and side airbags 16, 18, but does not cure -- and is not asserted to cure -- the deficiencies of the Ide reference as to at least the above-mentioned feature of claim 12, as presented.

Accordingly, claim 12, as presented, is allowable.

Claim 21, as presented, includes features similar to those of claim 12, and is therefore allowable for essentially the same reasons as claim 12, as presented.

Claims 13 to 16 and 18 to 20 and claim 22 respectively depend from claims 12 and 21 and are therefore allowable for at least the same reasons as claims 12 and 21, as presented.

Accordingly, withdrawal of the obviousness rejections is respectfully requested.

In summary, claims 12 to 16 and 18 to 22 are allowable.

CONCLUSION

In view of the foregoing, claims 12 to 16 and 18 to 22 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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Dated: 1/16/2009

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